

REMARKS

Request for Personal Interview

Applicants request a personal interview with the Examiner before the Examiner issues the next Office Action.

Pending Claims

Currently pending are claims 1-31. Claims 1-29 are directed to a pointe shoe. Claims 30 and 31 are directed to a method of making a pointe shoe.

Summary of the Office Action

The Office Action rejects claims 1-31 under 35 U.S.C. § 103 as obvious over the combination of Dancewear 1999 in view of U.S. 5,035,069 ("Minden '069").

Discussion of the Objections and Rejections

Applicant respectfully submits that pending claims 1-31, as originally filed, are patentable over the prior art cited. To reject a claim as obvious over a combination of the prior art references, there must exist some suggestion or motivation, either in the prior art itself or in the knowledge of one of ordinary skill in the art, to combine the references as provided. See, e.g., M.P.E.P. § 2143. The mere fact that the prior art references can so be combined, absent a motivation to do so, is insufficient. See, e.g., *id.* Moreover, it is improper to employ hindsight gleaned from the Applicant's invention to support an obviousness rejection. Accordingly, Applicant submits that there is no such motivation to combine the ballet slipper taught in the Dancewear 1999 reference with the toe box pointe shoe of the Minden '069 patent.

The dance shoe of the present invention is directed to providing a pointe shoe having increased flexibility between the toe and the heel. This is accomplished by providing a toe box pointe shoe having a split sole design. The split sole design had not previously been incorporated into a pointe shoe.

Ballet slippers and pointe shoes are functionally different shoes for distinct styles of dance.

Ballet Slippers

Ballet slippers are traditionally made of soft, flexible materials such as supple leather or canvas in order to conform to the dancer's foot so that the slipper appears to move along

with bending and flexing of the foot. Ballet slippers have a soft toe and not a rigid toe box as in a pointe shoe. Consequently, using a ballet slipper, the dancer cannot dance on the tips of her toes without damaging her joints or tendons.

Pointe Shoes

Pointe dancing is an altogether distinct style and thereby requires a different style of shoe. In pointe dancing, the dancers dance upon the tips of their toes to further enhance the appearance of being suspended in air. To provide the required support, the traditional pointe shoe includes a toe box often made of rigid material resulting in sufficient strength for standing on pointe. Also often included is a shank which is typically made from a stiff material and provides support to the arch of the dancer's foot such that a portion of the dancer's weight is transferred from her toes. The sole of a pointe shoe is also traditionally made from a stiff material and extends along the length of the bottom of the shoe for providing additional support. Pointe shoe soles are traditionally not soft and flexible. Once the pointe shoes begin to soften and become flexible, they were no longer useful for traditional pointe dancing as they failed to provide the required support. Hence, while the split sole design facilitates the flexibility desirable in ballet slippers, that function was previously undesirable in pointe shoes. Therefore, there exists no motivation or suggestion to combine the split sole design known from ballet slippers in *Dancewear 1999* with the traditional toe box pointe shoe shown in the Minden '069 patent.

The difference between ballet slippers and pointe shoes is admitted by the inventor of the Minden '069 patent. Specifically, the inventor Minden states that "the ballet slipper is different from a hard pointe shoe". See U.S. patent publication US 2003/0070319 A1, Paragraph 0003.

Applicant further wishes to note that the Minden '069 patent, while recognizing a problem addressed in the present invention, seeks to solve this problem in a vastly different way. Specifically, the Minden '069 patent recognizes that dancers often physically break-in new pointe shoes to increase their flexibility, but that doing so decreases the shoe's useful life. See, e.g. Col. 1, lines 29-40. This problem is resolved, as the Minden '069 patent discloses, by providing a pointe shoe having an integral shank and toe box made of flexible thermoplastic material. See, e.g., Col. 2, lines 42-46. Accordingly, no motivation exists to incorporate the split sole design as disclosed in *Dancewear 1999* with the Minden '069 patent and thus independent claims 1 and 31 are patentable over these prior art references.

In re Appln. of BARUCK
Application No. 10/033,987

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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